

Remarks

I. Status of the Subject Application

Claims 1-24 are currently pending in the Subject Application. Claims 1-20 have been rejected by the Examiner. Dependent Claims 21-24 are new.

II. Rejections Under 35 U.S.C. § 103(a)

Independent Claims 1, 14, and 15, along with various dependent claims, have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,766,561 to Frieze et al. ("Frieze '561") in view of U.S. Patent No. 5,815,995 to Adam ("Adam '995"). Dependent Claim 7 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Frieze '561 in view of Adam '995 and in further view of U.S. Pub. No. 2001/0046582 to Kerr et al. ("Kerr '582"). Independent Claim 1 and Dependent Claim 7 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Frieze '561 in view of U.S. Patent No. 4,429,068 to Nakahira ("Nakahira '068").

Frieze '561 in view of Adam '995

The rejection of Independent Claims 1, 14, and 15 under the combination of Frieze '561 in view of Adam '995 is improper for at least two reasons. First, the combination does not provide all of the recited elements of Independent Claims 1, 14, and 15. *In re Wilson* states that in rejections under 35 U.S.C. § 103(a), "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (CCPA 1970), *see also*, MPEP §2143.03. Notably, the Examiner admits that Frieze '561 "does

not appear to disclose that the pattern on the downwardly facing surface [of the mat] is such that no fold line can traverse the mat from one side to the other without intersecting a plurality of ridges” (see Office Action, page 3). In an attempt to correct such deficiencies, the Examiner points to Adam ‘995 as disclosing a mat having the recited ridges in Independent Claim 1, for example. However, Adam ‘995 does not disclose a mat with such features but, instead, discloses a slip-resistant floor tile which is not a mat. In fact, Adam ‘995 goes so far as to disparage the use of mats in col. 1, lines 46-67, and refers only to a slip-resistant floor tile throughout the specification, thereby making a distinction between a mat and the slip-resistant floor tile. In effect, Adam ‘995 teaches away from a mat. As a result, Applicant submits that the teachings of Frieze ‘561 and Adam ‘995 cannot be combined.

Second, Adam ‘995 is not within an analogous art to the art of Independent Claims 1, 14, and 15 and, therefore, cannot be used in a 35 U.S.C. § 103(a) rejection thereof. In fact, the Federal Circuit has stated that the cited references in an obviousness rejection **must** be in the field of the inventor’s endeavor or reasonably pertinent to the specific problem with which the inventor was involved. See *In re Deminski*, 796 F.2d 436, 442 (Fed. Cir. 1986). The field of endeavor of Adam ‘995 is plainly stated therein:

The invention relates generally to the **field of floor coverings**, and in its preferred embodiments, to **slip resistant floor coverings** for application in pre-determined **hazardous areas**.

More particularly, the present invention includes a slip-resistant floor covering apparatus and method which employ a **slip-resistant tile**...

See col. 1, lines 14-17 and col. 2, lines 14-16 (emphasis added). Applicant respectfully submits that such an endeavor is simply not within the field of endeavor of the invention of Independent

Claims 1, 14, and 15, i.e., a mat for use in a **sterilization container system** which is configured to prevent, or at least inhibit, fold lines from traversing the mat which can, in various circumstances, prevent medical instruments positioned on the upwardly facing surface of the mat from contacting each other, or otherwise shifting, during a sterilization process. Nor is the problem that Adam '995 is directed to, i.e. diminishing the probability of slip and fall mishaps by producing secure footing in otherwise hazardous areas (see col. 2, lines 2-4), at all pertinent to the problem solved by the invention of Independent Claims 1, 14, and 15 owing to the fact that no one would stand on the mat of Independent Claims 1, 14, and 15 because it is configured to be positioned within a sterilization container. Further, the mat of Independent Claims 1, 14, and 15 would not be used in a hazardous area to provide secure footing but, instead, would be used in a sterile environment within a sterilization container. The Federal Circuit has indicated that a prior art reference is reasonably pertinent when:

it is one in which, because of the matter with which it deals, logically would have commended itself to the inventor's attention in considering his problem.... If a reference's disclosure **has the same purpose** of the claimed invention, the reference relates to the same problem.

In re Clay, 966 F.2d 656, 659 (Fed. Cir. 1992) (emphasis added). As stated above, the purpose of the device of Adam '995 is to provide a slip-resistant floor tile which reduces the risk that an individual may slip or fall on a slippery floor surface by supporting the individual's foot at an elevation above that of liquids and/or other potentially slip-inducing substances (see e.g., col. 2, lines 9-14). One of ordinary skill in the medical instrument sterilization art would not look to a modular slip-resistant floor tile to find the solution to the problem of keeping a medical

instrument mat within a sterilizer from rolling over onto itself to prevent, or at least inhibit, medical instruments from being damaged during a sterilization procedure.

Frieze '561 in view of Adam '995 and in further view of Kerr '582

Kerr '582 does not remedy the deficiencies of Frieze '561 in view of Adam '995 and, therefore, Applicant submits that Dependent Claim 7 is allowable with Independent Claim 1 from which it depends.

Frieze '561 in view of Nakahira '068

Similar to the above-described rejection of Independent Claims 1, 14, and 15, the rejection of Independent Claim 1 under the combination of Frieze '561 in view of Nakahira '068 is improper for at least two reasons. First, Nakahira '068 does not remedy the admitted deficiencies in Frieze '561. More particularly, Applicant submits that Nakahira '068 does not disclose a mat for use in a sterilization container system having **a pattern of ridges extending from a downwardly facing surface, wherein the pattern is such that no fold line can traverse the mat from one side to the other without intersecting at least one ridge**, as recited in Independent Claim 1. In an attempt to locate this claim recitation, the Examiner refers to Figs. 1-6 of Nakahira '068 but, on the contrary, Figs. 1-6 refer to a sheet-like body which does not have a pattern of ridges extending from a downwardly facing surface, **wherein the pattern is such that no fold line can traverse the mat from one side to the other without intersecting at least one ridge**. Notably, referring to Figs. 2 and 6, the radial projections 4 of Nakahira '068 form a pattern such that a fold line **could** traverse the body 1 from one side to the other, within

valleys 4b, for example, without intersecting at least one of ridge lines 4a (see e.g., Figs. 2 and 6). Further, Nakahira '068 does not disclose or suggest preventing, or at least inhibiting, the body 1 from folding. It is important to note that in rejections under 35 U.S.C. § 103(a), "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (CCPA 1970), *see also*, MPEP §2143.03. The rejection of Independent Claim 1 under the combination of Frieze '561 in view of Nakahira '068 does not provide all of the recited elements of Independent Claim 1 and, therefore, Independent Claim 1 should be allowed.

Second, Nakahira '068 is not within an analogous art to the art of the claimed invention and, therefore, Nakahira '068 cannot be used in a 35 U.S.C. § 103(a) rejection thereof. In fact, the Federal Circuit has stated that the cited references in an obviousness rejection **must** be in the field of the inventor's endeavor or reasonably pertinent to the specific problem with which the inventor was involved. See *In re Deminski*, 796 F.2d 436, 442 (Fed. Cir. 1986). The field of endeavor of Nakahira '068 is:

A rubber material having excellent vibration-proof, sound-proof, shock-absorbing and cushioning properties.

See e.g., col. 1, lines 30-33. Applicant respectfully submits that such an endeavor is simply not within the field of endeavor of the invention of Independent Claim 1, i.e., a mat for use in a **sterilization container system**, wherein the mat includes a pattern of ridges extending from a downwardly facing thereof, and wherein the pattern is such that no fold line can traverse the mat from one side to the other side without intersecting at least one ridge. Nor is the problem that Nakahira '068 is directed to, i.e., making rubber materials having vibration-proof, sound-proof,

shock-absorbing, and impact resisting properties (see e.g., col. 4, lines 25-30), at all pertinent to the problem solved by the invention of Independent Claim 1. The Federal Circuit has indicated that a prior art reference is reasonably pertinent when:

it is one in which, because of the matter with which it deals, logically would have commended itself to the inventor's attention in considering his problem.... If a reference's disclosure **has the same purpose** of the claimed invention, the reference relates to the same problem.

In re Clay, 966 F.2d 656, 659 (Fed. Cir. 1992) (emphasis added). As stated above, the purpose of the device of Nakahira '068 is to provide a rubber material having excellent vibration-proof, sound-proof, shock-absorbing, and cushioning properties (see e.g., col. 1, lines 30-33). One of ordinary skill in the sterilization art would not look to such a rubber material to solve the problem of preventing, or at least inhibiting, a sterilization mat from folding over itself in a sterilization container system to prevent instruments from being damaged by contacting each other, or otherwise shifting, during a sterilization process.

In addition to the above, the combination of Frieze '561 in view of either Adam '995 and/or Nakahira '068 can not be used to reject Independent Claims 1, 14, and 15 under 35 U.S.C. § 103(a) as the various combination are respectfully made solely by an impermissible hindsight based reconstruction. As stated in §2142 of the MPEP:

The tendency to resort to "hindsight" based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight **must be avoided** and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

MPEP §2142 (emphasis added), *see also, In re Deminski*, 796 F.2d 436, 443 (Fed. Cir. 1986). Applicant respectfully submits that a person of ordinary skill in the art would not have been motivated to modify the device of Frieze '561 in view of Adam '995 and/or Nakahira '068 to

arrive at the invention of Independent Claims 1, 14, and 15. Further, Applicant would like to respectfully remind the Examiner that he bears the burden of providing an **apparent reason** for combining the teachings of the cited references and such an apparent reason must be express. *KSR International Co. v. Teleflex Inc. et al.*, 127 S. Ct. 1727 (2007). The Examiner has not provided a legally sufficient apparent reason to combine Frieze '561 with Adam '995 or Nakahira '068. As a result, Applicant submits that the various rejections made by the Examiner under 35 U.S.C. § 103(a) are based solely on impermissible hindsight.

In view of the above, Applicant respectfully submits that the 35 U.S.C. § 103(a) rejections of Independent Claims 1, 14, and 15, and the claims depending therefrom, must be withdrawn.

III. New Dependent Claims 21-24

New Dependent Claims 21-24 recite, among other things, a first set of ridges, wherein at least one ridge of the first set of ridges is discontinuous to create a first aperture therein, and wherein the first aperture is configured to allow a fluid to flow therethrough, and a second set of ridges, wherein at least one ridge of the second set of ridges is discontinuous to create a second aperture therein, wherein the second aperture is configured to allow a fluid to flow therethrough, and wherein the first aperture is configured to be in fluid communication with the second aperture such that a fluid can flow through the first aperture and the second aperture.

Applicant respectfully submits that the above-recited features are not disclosed or suggested by any of the references cited in the Office Action and, therefore, Dependent Claims 21-24 are allowable.

IV. Status of Other Cases

U.S. Patent Application Serial No. 11/958,904, filed on December 18, 2007, entitled STERILIZATION TRAY AND MAT, has yet to receive an Office Action.

V. Conclusion

Applicant respectfully submits that all of the claims presented in the Subject Application, as either amended or initially presented in this Amendment, are in condition for allowance. Applicant's present Amendment should not in any way be taken as acquiescence to any of the specific assertions, statements, etc., presented in the Office Action not explicitly addressed herein. Applicant reserves the right to specifically address all such assertions and statements in subsequent responses.

Applicant has made a diligent effort to properly respond to the Office Action and believes that the claims are in condition for allowance. If the Examiner has any remaining concerns, the Examiner is invited to contact the undersigned at the telephone number set forth below so that such concerns may be expeditiously addressed.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Christian M. Best', with a long horizontal flourish extending to the right.

Christian M. Best
Registration No. 49,082

Attorney for Applicant

K&L GATES LLP
Henry W. Oliver Building
535 Smithfield Street
Pittsburgh, Pennsylvania 15222-2312
Telephone: (412) 355-8636
Facsimile: (412) 355-6501